

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL B. SCHROEDER

Appeal 2007-1442
Application 09/826,664¹
Technology Center 2100

Decided: November 27, 2007

Before LEE E. BARRETT, ALLEN R. MACDONALD, and CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, C., *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a Final Rejection of claims 1-49 entered April 19, 2006. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Application filed April 5, 2001. The real party in interest is International Business Machines Corporation.

We reverse but enter a new ground of rejection as to claims 47-49.

Appellant invented a system, method, and computer readable medium for creating symbolic links to bookmarks (Appellant's Specification 1:9-12).

The appeal contains claims 1-49. Claims 1, 9, 21, 30, 36, 41, 47, 48, and 49 are independent claims. As best representative of the disclosed and claimed invention, claims 1 and 47 are reproduced below:

1. A method in a data processing system for creating symbolic links to bookmarks, comprising:

receiving a request to create a new bookmark for a document;

in response to receiving the request, determining whether a reference bookmark already exists for the document;

if the reference bookmark for the document already exists, creating a symbolic link; and

linking the symbolic link to the already existing reference bookmark, wherein a new bookmark is not created.

47. A computer program product, in a computer readable medium, for creating symbolic links to bookmarks, comprising:

instructions for receiving a request to create a new bookmark for a document;

in response to receiving the request, instructions for determining whether a reference bookmark already exists for the document;

instructions for creating a symbolic link if the reference bookmark for the document already exists; and

instructions for linking the symbolic link to the already existing reference bookmark, wherein a new bookmark is not created.

REFERENCES

The references relied upon by the Examiner in rejecting the claims on appeal are as follows:

Reiter	US 5,642,503	Jun. 24, 1997
Bauersfeld	US 5,917,491	Jun. 29, 1999
Himmell	US 6,037,934	Mar. 14, 2000
Murphy	US 6,096,096	Aug. 1, 2000
Shwarts	US 6,243,071 B1	Jun. 5, 2001 (filed Nov. 3 1993)
Crandall	US 6,321,228 B1	Nov. 20, 2001 (filed Aug. 31, 1999)
Isreal	US 6,330,007 B1	Dec. 11, 2001 (filed Dec. 18, 1998)
Khan	US 6,427,175 B1	Jul. 30, 2002 (filed Sep. 24, 1999)
Khan	US 6,460,038 B1	Oct. 1, 2002 (filed Sep. 24, 1999)

The Examiner entered a Final Rejection on April 19, 2006 with the following eleven (11) rejections which are before us for review:

(1) Claims 1, 9, 10, 30, 36, 37, 47, and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Khan '038 in view of Murphy and further in view of Shwarts².

² The Final Office Action erroneously lists this rejection under 102(e) as being anticipated by the cited references. The Board views this as a typographical error.

(2) Claims 2, 3, 5, 15, 16, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Khan ‘038, Murphy, and Shwarts and further in view of Bauersfeld.

(3) Claims 4, 20, and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Khan ‘038 in view of Murphy and Shwarts and further in view of Reiter.

(4) Claims 6, 17, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Khan ‘038, Murphy, Shwarts, and Bauersfeld, further in view of Himmel.

(5) Claims 7, 8, 34, and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Khan ‘038, Murphy, and Shwarts, further in view of Isreal.

(6) Claims 11-14, and 38-40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Khan ‘038, Murphy, and Shwarts, further in view of Crandall.

(7) Claims 18 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Khan ‘038, Murphy and Shwarts, further in view of Isreal, further in view of Bauersfeld.

(8) Claims 21, 22, 41, 42, and 49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Khan ‘038, Murphy and Shwarts, further in view of Khan ‘175.

(9) Claims 23-26, and 43-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Khan '038, Murphy, Shwarts, and Khan '175, further in view of Crandall.

(10) Claims 27 and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Khan '038, Murphy, Shwarts, Khan '175, and further in view of Bauersfeld.

(11) Claim 29 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Khan '038, Murphy, Shwarts, Khan '175, and further in view of Reiter.

Appellant appealed from the Final Rejection and filed an Appeal Brief (Br.) on June 27, 2006. The Examiner mailed an Examiner's Answer (Answer) on October 5, 2006. No Reply Brief was filed.

ISSUES

The issue is whether Appellant has shown that the Examiner erred in rejecting representative claim 1 based on obviousness? The issue specifically turns on whether it would have been obvious to create a symbolic link if the reference bookmark for a document already exists.

FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Murphy

1. Murphy describes that “the virtual document root is fundamentally composed of a symbolic link (symlink) to any one of the mounted compact discs in order to provide access to the common files.” (Col. 9, ll. 16-19.)
2. Murphy further describes that “the virtual document root of the present invention is further comprised of a toolbox directory composed of symlinks to files and directories on the compact discs. These symlinks are static links which are created when the portable, off-line, Web site is created during the installation of the present invention. . . . the installation of the present invention happens in the background and is, thus, hidden from the end-user.” (Col. 9, ll. 25-36.)

Embodiments of Appellant’s Invention

3. At page 15, lines 3-9, of the Specification, Appellant states that “[e]xamples of computer readable media include . . . transmission-type media, such as digital and analog communications links, wired or wireless communications links using transmission forms, such as, for example, radio frequency and light wave transmissions.”

PRINCIPLES OF LAW

The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966), stated that three factual inquiries underpin any determination of obviousness:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (*citing In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. *Oetiker*, 977 F.2d at 1445. *See also Piasecki*, 745 F.2d at 1472.

Rejections on obviousness grounds cannot be sustained by mere conclusory statements. *KSR*, 27 S.Ct. at 1741 (*citing Kahn*, 441 F.3d at 988).

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. “In reviewing the [E]xaminer’s

decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *Oetiker*, 977 F.2d at 1445. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Further, a rejection based on section 103 must rest upon a factual basis rather than conjecture, or speculation. “Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand.” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). *See also Lee*, 277 F.3d at 1344 and *Kahn*, 441 F.3d at 988.

The scope of patentable subject matter under section 101 is broad, but not infinitely broad. “Congress included in patentable subject matter *only* those things that qualify as ‘any … process, machine, manufacture, or composition of matter, or any … improvement thereof....’” *In re Warmerdam*, 33 F.3d 1354, 1358 (Fed. Cir. 1994) (quoting 35 U.S.C. § 101) (emphasis added). Thus, “[d]espite the oft-quoted statement in the legislative history of the 1952 Patent Act that Congress intended that statutory subject matter ‘include anything under the sun that is made by man,’[citation omitted], Congress did not so mandate.” *Id.*

ANALYSIS

It is undisputed that Shwarts teaches “determining whether a bookmark already exists” (Br. 17) and Kahn teaches “the creation of a bookmark where a command is received to create a bookmark” (Br. 17).

According to the Examiner, “Murphy discloses the use of symbolic links.” (Answer 4.) However, Appellant contends that “*Murphy* teaches a method of creating symbolic links to information on mounted compact discs. *Murphy* does not teach or suggest creating a symbolic link if the reference bookmark for the document already exists and linking the symbolic link to the already existing reference bookmark, wherein a new bookmark is not created.” (Br. 19.) We agree with Appellant.

While Murphy discloses symbolic links (FF 1), we find that Murphy’s creation of such “symbolic links” are not tied to any pre-condition or request, as set forth in the present invention. For example, instead of creating a symbolic link *if* a bookmark already exists, Murphy merely creates symlinks to files and directories on a compact disc when the portable web site is created (FF 2). As such, Murphy does not rely upon a request to create a symbolic link nor does Murphy looks for a condition to be met first. In Murphy, there is no connection between an already existing bookmark and the symlink (Answer 16). In other words, the creation of Murphy’s “symlinks” are not based on an “if” condition nor a request to create a symbolic link. Instead, Murphy’s symlinks are done in the background, hidden from the end-user (FF 2). In addition, as conceded by the Examiner,

we also find that both Kahn ‘038 and Shwarts fail to teach providing symbolic links to bookmarks (Answer 15).

As such, we reverse rejection (1) as listed *supra* pertaining to representative claim 1 and the claims grouped therewith. As for rejections (2) – (11) listed *supra*, because all the claims share the feature surrounding pre-existing bookmarks and the creation of symbolic links based on either a pre-condition being met or a request being made as discussed *supra*, rejections (2) –(11) are also reversed.

Therefore, we will not sustain and will instead reverse the Examiner’s rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

NEW GROUND OF REJECTION

In addition to reversing the Examiner’s rejection of claims 1-49, this decision, pursuant to our authority under 37 C.F.R. § 41.50(b), contains a new ground of rejection.

Claims 47-49 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 47 reproduced *supra*, is representative.

Specifically, claim 47 is directed to “[a] computer program product, in a computer readable medium . . . ” and Appellant explicitly discloses that “computer-readable media include . . . transmission-type media, such as digital and analog communications links . . . ” (FF 3).

We find that Appellant's description of a 'computer readable media' implicates intangible signals despite the absence of such term in the description.

That said, the issue, quite simply, is whether a claimed computer readable media that is broad enough to include transmission-type media – a media that includes intangible signals – is statutory subject matter. The Federal Circuit recently held that an intangible signal is not statutory subject matter because it does not fall within any of the four categories of statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). In this instance, claim 47 includes both statutory subject matter (signals stored on a tangible medium) and non-statutory subject matter (intangible signals in a transmission medium). According to recent proposed USPTO interim guidelines, it must be amended to recite solely statutory subject matter.³

Even if an intangible signal could be considered to be an article of manufacture, however, we find that such a signal does not operate as the claimed computer readable media. Claim 47, for example, recites a computer readable medium having instructions for causing a computer to execute a method. As a result, it is our view that the computer cannot perform the claimed functions while the instructions are within a carrier

³ See also "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility," 1300 Off. Gaz. Pat. Office 142, Annex IV(C)(2)(Nov. 22, 2005) ("[A] claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application.").

wave or a signal. In other words, the information, while in the transmission medium, is unavailable to the computer for performing the functions recited in claim 47.

For the above reasons, we find that claims 47-49 recite non-statutory subject matter. The “medium” of claims 48 and 49 share the same interpretations as discussed *supra* for “medium” in claim 47. For the reasons *supra*, we conclude that claims 48 and 49 are also directed to non-statutory subject matter.

37 C.F.R. § 41.50(b)

37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b) as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...

(2) *Request rehearing*. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

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CONCLUSIONS

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1-49 as being unpatentable under 35 U.S.C. § 103(a).

DECISION

In view of the foregoing discussion, we reverse the Examiner's rejection of claims 1-49.

Under 37 C.F.R. § 41.50 (b), we have entered a new ground of rejection against claims 47-49 under § 101.

Since we have entered a new ground of rejection against claims 47-49, our decision is not a final agency action.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

REVERSED
37 C.F.R. § 41.50(b)

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